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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,620	01/09/2002	Jason C. Gilmore	47079-0129	4385

7590 06/21/2004

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EXAMINER	
MOSSER, ROBERT E	

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/042,620	GILMORE ET AL.	
	Examiner	Art Unit	
	Robert Mosser	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

In response to the amendment and arguments dated March 26, 2004

Drawings

The communication filed March 26th, 2004 notes the inclusion of replacement drawings, however no such document is presently associated with the case. Resubmission of the described figure is suggested.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9 and 11-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Moody et al (US 5,976,016).

Regarding at least claims 1-3, 8, 11-13 and 18. Moody et al discloses a multi-line slot machine method including the receiving of wagers from players, displaying to the player on a first row of the slot machine a plurality of symbols, allowing the player to select which of the symbols to hold, and generating random replacement symbols for the symbols not held, and awarding a prize according to the symbols and the pay table (Figures 1-3 & Col 1:33-48). Thus, in response to a wager the player selects the symbols to hold and the award is determined by the combination of these selected and adjacent non-selected symbols along the pay line providing the respective reward outcomes in accordance with the pay table.

Regarding at least claims 4 and 14, Moody et al teaches the payout dependent on multiple combinations with associated payouts or an award payoff as so described (Col 4:10-24).

Regarding at least claims 5, 7, 15, and 17, Moody et al teaches the awarding a bonus round or a bonus game as so described resultant of a special combination being obtained in the method described previously (Col 6:16-28).

Regarding at least claims 6 and 16, Moody et al teaches the use of traditional mechanical slot wheels that are stacked vertically and are rotated vertically before being stopped in vertical association with the display area (Col 6:49-64).

Regarding at least claims 9 and 19, Moody et al teaches the display of a plurality of selectable elements in a matrix including a plurality of rows and columns and wherein at least one of the non-elected elements for which the outcome is awarded includes a plurality of the non-selected elements adjacent to the selected element (Figures 1-3).

3. Claims 21-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Schneider et al (US 6,089,976).

Regarding at least claims 21 and 26, Schneider et al teaches a method for a game of chance on a gaming machine including receiving a wager from a player (Col 4:29-40), conducting a primary game, starting a secondary game response to a start-secondary game outcome in the primary game, and starting a primary game response to a start-primary game outcome in the secondary game (Figure 7). The start outcomes are understood as the qualifying outcome and the outcome of matching two

rewards in the secondary game of Schneider. Where the game mechanics of the primary and secondary game are not the same mechanics and where in the primary game of Schneider et al is under stood as the secondary game of the applicant while the secondary game of Schneider et al is under stood as the primary game of the applicant.

Regarding at least claims 22, 23, 27, and 28, Schneider et al teaches his secondary game as including interactive selection wherein the player selects an element and receives the award associated with the selection of an element prior to selecting at least one more element (Col 2:65-3:16 & Figures 2-4). As stated above the primary game of Schneider et al is under stood as the secondary game of the applicant while the secondary game of Schneider et al is under stood as the primary game of the applicant.

Regarding at least claims 24, 25, and 31, and in addition to the above stated in the rejection of claims 21-23 and 26-28. Schneider et al teaches the use of a slot reel game including a plurality of symbol bearing slot reels that are rotated and stopped to place a symbols on the reels in visual association with a display area in a primary game (Col 5:9-33 & Figure 1).

Regarding at least claims 29 and 30. Schneider et al teaches the step of conducting a primary slot game including awarding a payout based on the symbols displayed in the display area of a video display (Col 5:20-33 & Col 2:57-64). As stated above the primary game of Schneider et al is under stood as the secondary game of the

applicant while the secondary game of Schneider et al is under stood as the primary game of the applicant.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al (US 5,976,016) as applied to claims 1 and 11 above, and further in view of Schneider et al (US 6,089,976).

Moody et al is silent as to the use of an animated pattern encompassing the selected element in response to the selection. Schneider et al teaches the use of an animated pattern for the purpose of removing all of the elements that have not been selected and the elements that have been selected but do not form a pair (Figures 2-5 & Col 4:47-63). It would have been obvious for one of ordinary skill in the art at the time of invention to have utilized the animated pattern of Schneider et al in the invention of

Moody et al in order to emphasis the winning combinations and play lines that contain these combinations.

Response to Arguments

Applicant's arguments filed 3-26-2004 have been fully considered but they are not persuasive.

The presented arguments are deficient based on the following points:

First, the applicant argues that Moody et al (US 5,976,016) fails to disclose a plurality of elements associated with respective "outcomes" but instead teaches a plurality of elements with an associated "outcome".

The language of the present claims 1 and 11 include elements that are associated with an outcome. This "association" includes any possible relationship between the element and the outcome and therefore is understood presently to encompass, an element representing a portion of an outcome. The applicant seems to be arguing the magnitude, type, and the degree of the association between the prize and the element, however this limiting interpretation is not presently supported.

The language further describes the result of the association as an outcome. An outcome as presently understood in claims 1 and 11, encompasses any result be it the awarding of monetary prizes, the awarding of game credits, the awarding of game symbols, awarding of a bonus game, and many more instances wherein any result is yielded. The applicant seems to be arguing the magnitude, type, and the amount of the

prize that defines an outcome, however this limiting interpretation is not presently supported.

Thus in summation of the first point an element is understood to be associated with a portion of a winning/loosing game event while the awarding or selection of a symbol is understood to be an outcome for each of the selectable elements.

Second, the applicant argues that Moody et al fails to disclose a process wherein awarded outcomes are associated with a selected and a non-selected element. However this issue as repeated above and clarified herein is well encompassed in the core of the invention of Moody et al. Specifically, Moody teaches the holding of reel symbols on a first set of reels for the determination of symbol combinations on later determined sets (Abstract 7 & Figures 1-3).

Thus in view of point one Moody award the outcome of a partial symbol/win/loss by the selection the hold reels and the non-selected outcomes of randomly determined reels.

Third, the applicant argues that Moody et al fails to teach the revealing of the selected and non-selected elements in their respective locations as presented in claims 2 and 11. However as can be clearly seen in figure 2 the selected symbol is revealed in it's respective location (i.e. column) for bet lines 2 through 5 and in figure 3 the non-selected symbols are selected for their respective column in each bet line in similar fashion.

Forth, the applicant argues the limitation of "conducting a primary game again", as presented in claim 21, is not taught by Schnieder et al (US 6,089,976).

Schnieder however teaches a flow chart in figure 7 that severs to further explain the invention as described in the citations present by the applicant. As can be seen by the flow diagram the game proceeds from conclusion of the secondary matching game to the start of the primary game after allowing the player to placer their wager. While the examiner agrees that the user of Schnieder's invention is permitted to place a wager amount in between the conclusion of the secondary game and the initiation of the primary game this servers in no way to preclude the fact that it does return to the primary game after the play of the secondary game. Further along this line of reasoning it is unclear how the applicant intends their game of chance to function without allowing players to place wagers. Alternatively the player of Schnieders game must conclude the secondary game prior to participating in the primary game again or as the game as presented is a game of chance the wager would be required and so may be considered a portion of the primary. Any distinction between the initial deposit of monies and the wager amount is believed clarified in the applicants own citations of Schnieder as found on page 9 of the remarks dated March 26, 2004.

Fifth, the applicant argues the arrangement of game types.

As restated above in the rejection of at claims 21 and 26 "the primary game of Schneider et al is under stood as the secondary game of the applicant while the secondary game of Schneider et al is under stood as the primary game of the

applicant." Hence the correlation as presented previously presents a wheeled slot as the secondary game and the selection game as the primary game.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (703)-305-4253. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

REM

JESSICA HARRISON
PRIMARY EXAMINER